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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,956	03/16/2001	Aiko Hanyu	COS-822	7257

7590

10/04/2002

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EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 10/04/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/810,956

Applicant(s)

HANYU ET AL.

Examiner

D. Lawrence Tarazano

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 3 6) ☐ Other:

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "metallocene-catalyzed isotactic random copolymer" is confusing since the term random usually means that the propylene tails are randomly oriented along the polymer back bone; this is in stark contrast to the orderly arrangement seen for isotactic polymers. Therefore, the term random isotactic polymer is confusing. If the applicants mean that there is "random comonomer distribution" in the polymer, then the applicants should make it is clear what material is meant to be random.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9, 11-15 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-11-060833.

The Japanese patent document teaches monolayer heat sealable films made from a metallocene-catalyzed propylene copolymer. The polymers are isotactic in nature and have

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random comonomer distributions of the comonomer. The materials have good seal / melt properties [0025] and table 1. The comonomers present include those claimed and they are in the claimed amounts. Given the catalytic systems and the starting materials, there is reason to believe that the materials taught would have the claimed physical properties.

It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). When there is sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

5. Claims 1-42 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0-669-348  
A-1

The European patent teaches propylene copolymers made by metallocene catalysis, which have desirable sealing characteristics. The materials are used in the formation of monolayer and multi-layer films in which a thin sealant layer (100 microns) is placed on a base layer of polypropylene (500 microns) to yield a film in which the sealant layer composes 20% of the film.

The comonomers present include those claimed and they are in the claimed amounts. Given the catalytic systems and the starting materials, there is reason to believe that the materials taught would have the claimed physical properties.

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It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). When there is sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0-669-348 A-1 in view of JP-11-060833 or the converse.

The European patent teaches oriented films having a base layer of isotactic polypropylene and a heat sealable propylene layer made by metallocene catalysis. The patent also shows that is common in the art to use a sealable layer on a polypropylene substrate to improve the sealing properties of the film.

The Japanese document teaches random / isotactic propylene copolymers made by metallocene catalysis, which have good seal properties.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the materials taught by JP-11-0608833 as the surface layer in

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the films taught by EP 0-669-348 A-1, in order to produce heat sealable films. The metallocene catalyzed polypropylenes taught are functionally equivalent heat sealable materials and this is merely the substitution of one functionally equivalent material for another.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the polymers taught by JP-11-060833 in multilayer and optionally oriented films since it is common in the art to make conventional isotactic polypropylene heat sealable by the addition of a sealable layer.

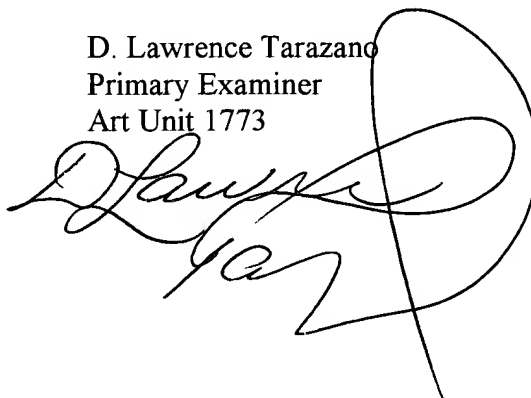
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano  
Primary Examiner  
Art Unit 1773

A large, stylized handwritten signature in black ink, likely belonging to D. Lawrence Tarazano, is written over the printed name and title.

dlt  
October 1, 2002